

REMARKS

Method claims 3, 6, 12, 14, 16, and 18-33 have been canceled without prejudice to the filing of a divisional application directed thereto. Composition claim 34 has been amended based on the disclosure at, e.g., page 10, lines 30-33 in the present application. Composition claims 35-41 have been added corresponding to the composition claims presented in the Amendment filed on September 27, 2010, except that claims 35 and 41 include an additional limitation based on the disclosure at page 10, line 30 to page 11, line 31 (see, e.g., the disclosure at page 10, line 35 to page 11, line 1 in particular). Composition claims 42-53 correspond to original claims 1-12, although claim 42 includes an additional limitation based on the disclosure at page 10, line 30 to page 11, line 31 (see, e.g., the disclosure at page 10, line 35 to page 11, line 1 in particular).

Entry of the above amendment is respectfully requested.

PTO Communication dated May 13, 2011

Applicants note that the PTO dated May 13, 2011 indicates that the Amendment filed May 3, 2011 is not fully responsive because all the claims are now method claims which are independent and distinct from the previously claimed composition.

In response, Applicants note that claim 34 in the May 3, 2011 Amendment is a composition claim which was specifically presented to avoid the issue being raised by the Examiner, and that remarks with respect to claim 34 in particular were specifically presented in the May 3, 2011 Amendment. Accordingly, Applicants submit that the May 13, 2011 PTO communication was issued in error, and that claim 34 should have been examined on the merits, with the other claims being withdrawn as being directed to non-elected subject matter.

Nevertheless, to facilitate further prosecution, Applicants are responding to the PTO communication with the present Supplemental Amendment canceling the method claims, amending composition claim 34, and adding new composition claims.

New Claims 35-53 and Amended Claim 34

Applicants note that claims 35-41 have been added corresponding to the composition claims which were presented in the Amendment filed on September 27, 2010, and further including a limitation that “the aromatic hydrocarbon which is basically C₉ or C₁₀-based comprises at least one selected from the group consisting of a basically C₉ alkylbenzene-based mixed solvent, a basically C₁₀ alkylbenzene-based mixed solvent, and a basically C₁₀ alkylbenzene-alkylnaphthalene-based mixed solvent.” These mixed solvents, as used herein, mean solvent naphtha with a high aromatic component ratio disclosed at page 10, line 30 to page 11, line 31 of the present application, and do not mean mixed solvents obtained by mixing two or more aromatic hydrocarbons having 9 or 10 carbon atoms, each of which individually is commercially available.

Further, since the Examiner did not cite prior art disclosing the use of a mixed solvent of aromatic hydrocarbons, Applicants note that new claims 42-53 correspond to original claims 1-12 modified to patentably distinguish over the cited art by adding a limitation that the at least one type of aromatic hydrocarbon having 9 carbon atoms or more within the molecule comprises at least one selected from the group consisting of a basically C₉ alkylbenzene-based mixed solvent, a basically C₁₀ alkylbenzene-based mixed solvent, and a basically C₁₀ alkylbenzene-alkylnaphthalene-based mixed solvent. The merits of the use of these mixed solvents are that a mixture of a plurality of components provides excellent cleanability which is better than a

solvent consisting of one or a couple of components, that these mixed solvent are lower in cost than a mixed solvent prepared by mixing a plurality of components, etc.

Finally, with respect to amended claim 34, Applicants note that the claim now recites that the aromatic hydrocarbon which is basically C₉ or C₁₀-based comprises a solvent naphtha, which is neither taught nor suggested by the cited art.

Obviousness Rejections

In response to the obviousness rejections set forth in the Office Action of December 3, 2010, Applicants refer the Examiner initially to the remarks set forth in the Response filed March 3, 2011 and the remarks set forth above.

With respect to the remarks set forth above, Applicants wish to emphasize that the cited art does not teach or suggest the use of a mixed solvent of aromatic hydrocarbons as recited in the present claims, including:

- (1) the limitation in new claims 35-53 that “the aromatic hydrocarbon which is basically C₉ or C₁₀-based comprises at least one selected from the group consisting of a basically C₉ alkylbenzene-based mixed solvent, a basically C₁₀ alkylbenzene-based mixed solvent, and a basically C₁₀ alkylbenzene-alkylnaphthalene-based mixed solvent” as defined in the specification as discussed above, and
- (2) the limitation in amended claim 34 that “the aromatic hydrocarbon which is basically C₉ or C₁₀-based comprises a solvent naphtha.”

Further, Applicants have the following comments on the Advisory Action of March 15, 2011.

(A) With respect to the argument that the prior art does not teach or suggest the problem addressed by the present invention (pigment tends to remain when removing a photosensitive composition containing a pigment) and that a general method used to solve the problem is not known, the Examiner indicates out that the independent claims 3 and 19 are not directed to a method but to a composition.

On review, the Examiner's position appears to be directed to the discussion of the In re Omeprazole Patent Litigation case in the paragraph bridging pages 3-4 in the response filed March 3, 2011. However, as indicated at the beginning of that paragraph, the In re Omeprazole Patent Litigation case concerned a claimed product, just like the present claims concern a product (a photosensitive composition remover). Since method-related discussion was used in connection with product claims in the In re Omeprazole Patent Litigation case, Applicants submit that it is appropriate to use method-related discussion in connection with the present claims. Accordingly, Applicants submit that the Examiner's position in the Advisory Action is inappropriate in this regard.

(B) With respect to the argument that Examples 9-14 in Table 1 of the specification are within the scope of the claims, the examiner agrees. However, there Examiner indicates that there is no comparison of the composition of the instant application with the developer compositions of Kamayachi et al. and Koyanagi et al. (the closest prior art, which teach that the tetramethylbenzene may be used in a developer for a photosensitive composition).

In response, Applicants submit initially that as set forth in MPEP 716.02(e) III., "[a]lthough evidence of unexpected results must compare the claimed invention with the closest prior art, applicant is not required to compare the claimed invention with subject matter that does not exist in the prior art. In re Geiger, 815 F.2d 686, 689, 2 USPQ2d 1276, 1279 (Fed. Cir. 1987)

(Newman, J., concurring)." In this regard, Applicants submit that none of the Examples in Kamayachi and Koyanagi disclose the use of tetramethylene, so Applicants do not need to test an embodiment containing tetramethylene to represent the prior art. Indeed, Applicants note that none of the Examples in Kamayachi and Koyanagi disclose the use of an aromatic hydrocarbon at all. Accordingly, Applicants submit that Wyatt's Example 4, which contains an aromatic hydrocarbon (albeit a C12-based aromatic hydrocarbon) represents the closest specific embodiment disclosed in the cited art.

Thus, Applicants submit that the present invention is not obvious over the cited art, and withdrawal of these rejections is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Bruce E. Kramer
Registration No. 33,725

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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